

**REMARKS****I. General**

Claims 1-20 are pending in the current application. Claims 9-15 stand rejected under 35 U.S.C. § 101. Claims 1-20 stand rejected under 35 U.S.C. § 103. Applicant respectfully traverses the rejections of record.

**II. The 35 U.S.C. § 101 Rejections**

Claims 9-15 continue to stand rejected under 35 U.S.C. § 101 because the “claims describe a claim that could be performed by hand by a human being, and lack a technological basis such as a computer that is required to be statutory subject matter,” see the final Office Action at page 2. In previously responding to this rejection, Applicant provided authority showing that the claims as submitted recite statutory subject matter. In response to Applicant’s previously submitted arguments, the Examiner baldly asserts that “the statute has been interpreted to require inventions with a technological basis,” see the final Office Action at page 2, but offers no authority for this position. Applicant respectfully asserts that the Examiner has not established a *prima facie* showing that the subject matter of claims 9-15 does not meet the statutory requirements set forth in 35 U.S.C. § 101. Accordingly, Applicant believes that claims 9-15 are patentable over the 35 U.S.C. § 101 rejection of record.

However, in an effort to expedite issuance of the present application, Applicant has amended claim 9 to recite “storing, by a computer, a list of prohibited expressions” and “filtering said document using said computer”. It is believed that the foregoing redresses the Examiner’s stated, although unsupported, reasons for rejecting the claims.

**III. The 35 U.S.C. § 103 Rejections**

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lapierre, United States patent number 6,075,550 (hereinafter *Lapierre*), in view of DeStefano, United States patent number 6,184,885 (hereinafter *DeStefano*). Claims 2-5, 7, 10-12, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of Cragun et al., United States patent

number 5,832,212 (hereinafter *Cragun*). Claims 6, 13, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Aras et al.*, United States patent number 5,757,417 (hereinafter *Aras*). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Halim et al.*, United States patent number 6,304,881 (hereinafter *Halim*). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of *Dieterman*, United States Patent number 6,393,464 (hereinafter *Dieterman*). Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Dieterman*.

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the references lack proper motivation to combine in addition to lacking all the claim limitations.

In the previously submitted response, Applicant pointed out that *Lapierre* does not teach or suggest censoring a document or finding restricted terms or expressions in a document as set forth in independent claims 1, 9, and 16. In response, the Examiner states that “the text data content contained in the signal [of *Lapierre*] could easily be considered a document,” the final Office Action at page 9. Whether or not the text data content of *Lapierre* could be considered a document is not dispositive with respect to the patentability of the present claims. The Examiner carries the burden of showing that one of ordinary skill in the art would have understood the text data content of *Lapierre* had to be a document as set forth in the claims, without the benefit of hindsight based upon Applicant’s disclosure, see M.P.E.P. § 706.02(j). Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 1, 9, and 16 and the claims dependent therefrom.

Claim 1 recites “a text highlighter program for highlighting said restricted terms found in said document” and claims 9 and 16 recite “visibly marking ones of said prohibited expressions found in said document.” As previously asserted by Applicant, the express purpose of the closed caption censor of *Lapierre* is to “remov[e] objectionable language from the closed caption and audio portions of programming displayed on a television,” column 1, line 67, through column 2, line 2, such as to “regulate the programming content seen by children,” column 1, line 14. Yet the Examiner asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have highlighted words with a special condition in *Lapierre* in the manner of *DeStefano* in order to draw attention to them,” see the final Office Action at page 3. Accordingly, rather than removing the objectionable language, as required for the principle of operation of *Lapierre*, the modification proposed by the Examiner would highlight the objectionable language “in order to draw attention to them.”

“It is improper to combine references where the references teach away from their combination,” M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art cannot render the prior art unsatisfactory for its intended purpose, M.P.E.P. § 2143.01. The 35 U.S.C. § 103 rejection of record based upon modification of *Lapierre* in view of *DeStefano* is in direct contravention to the law because *Lapierre* teaches away from the combination and because the proposed modification would render the system of *Lapierre* unsatisfactory for its intended purpose. Moreover, in the present situation it follows, *a fortiori*, that one of ordinary skill in the art would not have been led to draw the attention of a viewer, such as a child, to highlighted objectionable text in the closed captioning displayed by *Lapierre*.

In response to Applicant’s previously submitted arguments, the Examiner states that “[e]ven if small details of the two inventions are not immediately compatible, obvious combinations of the general principles contained in the inventions could have easily been combined to produce a combined invention which would have satisfied the limitations of the claims,” see the final Office Action at pages 9-10. The foregoing is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination, M.P.E.P. § 2143.01 (citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). Accordingly, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Applicant asserts that a *prima facie* case of obviousness under 35 U.S.C. § 103 over *Lapierre* and *DeStefano* has not been established with respect to claims 1, 9, and 16 and the claims dependent therefrom. Moreover, the rejections of record relying upon various combinations of *Lapierre*, *DeStefano*, *Cragun*, *Aras*, *Halim*, and *Dieterman* do not cure the above identified deficiency in the *prima facie* case of obviousness.

#### IV. Summary

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004840-1 from which the undersigned is authorized to draw.

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